

REMARKS/ARGUMENTS

Claims 1-25 are pending in this Application.

Claims 1, 11, and 17-25 are currently amended. Applicants submit that support for the claim amendments can be found throughout the specification and the drawings.

Claims 1-25 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/731,655. Claims 18-24 stand rejected under 35 U.S.C. 101 because the claimed invention as being directed to non-statutory subject matter.

Claims 1, 10-12, 18 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0039545 to Nishizawa et al. (hereinafter "Nishizawa"), in view of U.S. Patent No. 7,039,807 to Spitz (hereinafter "Spitz"), and in view of U.S. Patent Application Publication No. 2003/0078880 to Alley et al. (hereinafter "Alley").

Claims 2, 3, 7, 16, 17, 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa, in view of Spitz, in view of Alley, and in view of U.S. Patent No. 7,146,500 to Hawkins et al. (hereinafter "Hawkins").

Claims 4-6, 13-15 and 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa, in view of Spitz, in view of Alley, and in view of U.S. Patent No. 6,584,459 to Chang et al. (hereinafter "Chang").

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa, in view of Spitz, in view of Alley, in view of Hawkins, and in view of U.S. Patent Application Publication No. 2002/0040431 to Kato et al. (hereinafter "Kato").

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa, in view of Spitz, in view of Alley, and in view of U.S. Patent No. 7,093,133 to Hopkins et al. (hereinafter "Hopkins").

Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa, in view of Spitz, in view of Alley, in view of Hawkins, and in view of Chang.

Objections to the Specification

Applicants have updated the references to application numbers as requested, thus, Applicants respectfully request reconsideration and withdrawal of the objections to the specification.

Objections to the Claims

Applicants have amended claims 1, 11, 17, 18, 24, and 25 as requested, thus, Applicants respectfully request reconsideration and withdrawal of the objections to claims 1, 11, 17, 18, 24, and 25.

Double-Patenting Rejection

Applicants respectfully traverse the rejections to claims 1-25 and request reconsideration and withdrawal of the rejections on the grounds of nonstatutory double patenting. Applicants may consider filing a terminal disclaimer upon issuance of the copending Application.

Claim Rejections Under 35 U.S.C. § 101

Applicants respectfully traverse the rejections to claims 18-24 request reconsideration and withdrawal of the rejections under 35 U.S.C. § 101 in light of the amendments to claims 18-24.

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-25 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based primarily on Nishizawa, in view of Spitz and in view of Alley. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Nishizawa with the teachings of Spitz, Alley, and others.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a

pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

Applicants respectfully submit that Nishizawa, Spitz, and Alley, either individually or in combination, fail to teach or suggest one or more of the claim limitations recited in each of claims 1-25.

Claim 1

Claim 1 recites a method of collecting an electronic signature for an electronic record stored in a database, the method comprising:

automatically creating an electronic record from data stored in a plurality of different database tables in response to an occurrence of a predetermined event;

storing an instance of the electronic record in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users associated with the database;

executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record; and

if execution of the rule results in a determination that an electronic signature is required, marking the instance of the electronic record as unsigned and initiating a request to collect the required electronic signature.

Applicants respectfully submit that Nishizawa, Spitz, and Alley, either individually or in combination, fail to teach or suggest each and every claim limitation recited in claim 1.

For example, the Office Action alleges that Nishizawa discloses in FIGS. 2 and 3 and paragraphs [0025], [0088]-[0090], [0117], and [0118] the feature recited in claim 1 of “automatically creating an electronic record from data stored in a plurality of different database tables in response to an occurrence of a predetermined event.” Applicants respectfully disagree.

Nishizawa teaches mechanisms that manage electronic files by which a user can easily confirm the original entity of an electronic file. To do so, Nishizawa provides a hash

value that uniquely identifies an electronic file when the electronic file is registered with the document management system of Nishizawa. (Nishizawa: FIG. 2, “registration of hash function”; FIG. 3, element 13).

Applicants respectfully submit that Nishizawa fails to teach or suggest that the electronic files registered by the document management system are created as recited in claim 1 from data stored in a plurality of different database tables in response to an occurrence of a predetermined event. Nishizawa simply discloses that the electronic file are data stored in a form of electronically prepare documents or paper documents converted to electronically prepared documents.

Furthermore, Applicants respectfully submit that the hash value created in Nishizawa is substantially different from an electronic record created from data stored in a plurality of different database tables in response to an occurrence of a predetermined event as recited in claim 1. In paragraph [0025], Nishizawa discloses that when an electronic file f is to be registered with the document management system, a summarized value for the input electronic file f is determined upon an input of the electronic file f for authorizing the original entity into the document management system. (Nishizawa: FIG. 3, element 13). Applicants respectfully submit that the process of creating the summarized value or hash value of Nishizawa is substantially different from the feature of “automatically creating an electronic record from data stored in a plurality of different database tables in response to an occurrence of a predetermined event” as recited in claim 1.

In paragraphs [0088]-[0090], Nishizawa discloses that the hash value obtaining function 13 of FIG. 3 include 1) a function to obtain a hash value (i.e., the summarized value for the electronic file f) by using a hash function (unidirectional hash function or less collision hash function) on the electronic file. Thus, as shown in FIG. 3 of Nishizawa, electronic file f enters hash value obtaining function 13 on which is determined the corresponding hash value. Accordingly, Nishizawa’s disclosure of creating a hash value based on an electronic file does not teach or suggest creating an electronic record from data stored in a plurality of different database tables in response to an occurrence of a predetermined event as recited in claim 1.

The Office Action further alleges that Nishizawa discloses in FIGS. 2 and 7 and paragraph [0100] the feature recited in claim 1 of “storing an instance of the electronic record in

a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users associated with the database.” Applicants respectfully disagree.

Nishizawa discloses in paragraph [0100] that the document history table 21 is a storage means where labels, hash values, URL, date, and ID are registered by the document history registering function. Thus, the document history table 21 of Nishizawa does not store any electronically prepared documents. Furthermore, the hash file stored in the history table, which as discussed above, is substantially different from the electronic record recited in claim 1 that is created from data stored in a plurality of different database tables in response to an occurrence of a predetermined event.

Accordingly, Nishizawa’s disclosure of storing either the electronic record or the hash value does not teach or suggest storing an instance of the electronic record created from data stored in a plurality of different database tables in response to an occurrence of a predetermined event in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users associated with the database as recited in claim 1.

Thus, Applicants submit that Nishizawa fails to teach or suggest the above recited features of claim 1. Applicants further submit that Spitz and Alley, either individually or in combination, fail to cure the above discussed deficiencies of Nishizawa.

The Office Action relies upon Spitz’s disclosure in Col. 3, lines 31-38 and Col. 6, lines 60-67 to allegedly cure the acknowledged deficiency that Nishizawa does not disclose the feature recited in claim 1 of “executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record.” The Office Action further relies upon Alley’s disclosure in FIG. 3 and paragraph [0090] to allegedly cure the acknowledged deficiencies that Nishizawa and Spitz fail to teach or suggest the feature recited in claim 1 of “if execution of the rule results in a determination that an electronic signature is required, marking the instance of the electronic record as unsigned and initiating a request to collect the required electronic signature.” Thus, the Office Action fails to establish a prima face case of obviousness where Nishizawa, Spitz, and Alley, either individually or in combination, disclose each and every one of the claim limitations of claim 1.

Thus, Applicants respectfully submit that claim 1 is allowable over the cited references.

Additionally, the Office Action alleges that Spitz discloses in Col. 3, lines 31-38 and Col. 6, lines 60-67 the feature recited in claim 1 of “executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record.” Applicants respectfully disagree.

In Col. 3, lines 31-38, Spitz discloses that the access control rules may identify at least one of a type and attribute of documents each user is authorized to have signed and the signing system may parse the document to be signed to determine at least one of a type and attribute of the document and compare the determined type and attribute of the document to the access control rules stored in the database to determine whether the user is authorized to have the document signed. Furthermore, in Col. 6, lines 60-67, Spitz discloses policies that define, for example, whom is allowed to have particular types of documents signed.

However, executing a rule to determine whether a user is authorized to have a document signed as in Spitz is substantially different from executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record as recited in claim 1. Thus, Applicants respectfully submit that Spitz fails to disclose the feature recited in claim 1 of “executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record.”

Furthermore, Spitz is directed to using digital signatures to authenticate or validate data. For example, a sender can “sign” the data by encrypting it using their own private key. The sender can then package the signed data by further encrypting it using the recipient’s public key. At the receiving end, the recipient decrypts the package using their own private key and then validates the sender’s signature by further decryption using the sender’s public key. (Spitz: Col. 1, lines 52-59). Thus, Spitz provides a central location for signing documents using authentication information unique to the signing system. Thus, the electronic signature to authenticate the system associated with data in Spitz is different from the electronic signature recited in claim 1 that is required to connote review and/or approval of the electronic record.

Accordingly, Spitz fails to teach or suggest the feature recited in claim 1 of “executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record.”

Finally, the Office Action alleges that Alley discloses in FIG. 3 and paragraph [0090] the feature recited in claim 1 of “if execution of the rule results in a determination that an electronic signature is required, marking the instance of the electronic record as unsigned and initiating a request to collect the required electronic signature.” Applicants respectfully disagree.

FIG. 3 of Alley merely shows the status of one or more documents as being signed. However, merely displaying the status of a document as being unsigned as in Alley is substantially different from marking the specific instance of the electronic record as unsigned as recited in claim 1. Alley merely displays the status of a document of “document name” with “file name.” Alley does not teach or suggest that the instance of the electronic record is marked as unsigned as recited in claim 1, but that status information can be added to other information displayed about the document in a GUI.

Accordingly, Spitz fails to teach or suggest the feature recited in claim 1 of “if execution of the rule results in a determination that an electronic signature is required, marking the instance of the electronic record as unsigned and initiating a request to collect the required electronic signature.”

Thus, the Office Action fails to establish a prima face case of obviousness where Nishizawa, Spitz, and Alley, either individually or in combination, disclose each and every one of the claim limitations of claim 1. Accordingly, Applicants respectfully submit that claim 1 is allowable over the cited references.

Claims 2-25

Applicants respectfully submit that independent claims 11, 17, and 25 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants respectfully submit that dependent claims 2-10, 12-16, and 18-24 that depend directly and/or indirectly from the independent claims 1, 11, and 17 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

Thus, Applicants respectfully traverse the rejections to claims 2, 3, 7, 16, 17, 23 and 24 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Nishizawa, Spitz, Alley, and Hawkins.

Applicants respectfully traverse the rejections to claims 4-6, 13-15 and 20-22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Nishizawa, Spitz, Alley, and Chang.

Applicants respectfully traverse the rejection to claim 8 and request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) based on Nishizawa, Spitz, Alley, Hawkins, and Kato.

Applicants respectfully traverse the rejection to claim 8 and request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) based on Nishizawa, Spitz, Alley, Hawkins, and Kato.

Applicants respectfully traverse the rejection to claim 9 and request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) based on Nishizawa, Spitz, Alley, and Hopkins.

Applicants respectfully traverse the rejection to claim 25 and request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) based on Nishizawa, Spitz, Alley, Hawkins, and Chang.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

/Sean F. Parmenter/
Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
SFP/pas
61080753 v1